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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,095	04/13/2004	Eiichi Ueda	KON-1870	6153

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LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

EXAMINER	
PERREIRA, MELISSA JEAN	
ART UNIT	PAPER NUMBER
1618	
MAIL DATE	DELIVERY MODE
07/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,095	UEDA ET AL.	
	Examiner	Art Unit	
	MELISSA PERREIRA	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-46* is/are pending in the application.

4a) Of the above claim(s) *46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/1/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 21-46 are pending in the application. Claim 46 is withdrawn from consideration (see below).

1. Newly submitted claim 46 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The instant invention (see independent claim 21) states that no organic solvent is used whereas claim 46 includes solvent (ethanol). See specification, page 24, paragraph 2 which explicitly defines ethanol as an auxiliary solvent and therefore cannot be used in the instant invention. Therefore the claim 46 is directed toward a distinct invention and is excluded from consideration. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 46 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Any objections and/or rejections from previous office actions that have not been reiterated in this office action are obviated.

Declaration

2. The declaration filed on 3/17/08 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejection of Otake et al. (US2004/0099976A1) or Castor (US 5,554,382) in view of Sachse et al. (*Invest. Radiol.***1997**, *32*, 44-50; pages provided are numbered 1-8) and further in view of Mackaness et al. (US 4,192,859) or the rejection of

Otake et al. (US2004/0099976A1) or Castor (US 5,554,382) in view of Sachse et al. (*Invest. Radiol.***1997**, *32*, 44-50; pages provided are numbered 1-8) and further in view of Klaveness et al. (US 5,676,928). The declaration provides for a weight percent of 15% of sample C (Otake et al. closest prior art) and a weight percent of 17% of sample D (inventive) where a weight percent of 2% is not a surprising and unexpected result as it could be anomalous. There are extraneous factors (i.e. human error) that can account for such as small weight percent difference. Multiple replications need to be performed to in order to show that it is not an anomalous result. Sample E involves the use of solvent (ethanol) in the preparation which is not included in the instant invention so this example (sample E) is excluded from consideration.

Response to Arguments

3. Applicant's arguments filed 4/11/08 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 21-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake et al. (US2004/0099976A1) or Castor (US 5,554,382) in view of Sachse et al.

(*Invest. Radiol.***1997**, *32*, 44-50; pages provided are numbered 1-8) and further in view of Mackaness et al. (US 4,192,859) as stated in the office action mailed 12/20/07.

6. Applicant asserts that the comparison of the sample A (of Mackaness et al.) and sample D provides for an increase in a factor of 34.

7. The closest prior art is not that of Mackaness et al. and therefore the resulting comparison is irrelevant. The closest prior art is that of Otake et al. or Castor and the weight percent of 15% of sample C (Otake et al. closest prior art) and a weight percent of 17% of sample D (inventive) where a weight percent of 2% is not a surprising and unexpected result as it could be anomalous. There are extraneous factors (i.e. human error) that can account for such as small weight percent difference. Multiple replications need to be performed to in order to show that it is not an anomalous result.

8. The comparison of the sample B (of Mackaness et al.) and sample D is not a comparison of the closest prior art. The closest prior art is that of Otake et al. and not that of Mackaness et al. and therefore the resulting comparison is irrelevant.

9. Claims 21-42,44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake et al. (US2004/0099976A1) or Castor (US 5,554,382) in view of Sachse et al. (*Invest. Radiol.***1997**, *32*, 44-50; pages provided are numbered 1-8) and further in view of Klaveness et al. (US 5,676,928) as stated in the office action mailed 12/20/07.

10. The applicant had no assertions with regard to this rejection.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Na et al. (US 5,326,552) as stated in the office action mailed 12/20/08.

12. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

13. Applicant does not clearly distinguish the Na et al. reference over the prior art as the declaration does not provide for any evidence of the superior or unexpected results over the reference of Na et al.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 21,22 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim claims 1,4,6,8-10 and 19 of copending Application No. 11/180849 as stated in the office action mailed 12/20/07.

16. Claims 21,22,25 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,5-8,10-12 and 14-17 of copending Application No. 11/187,397 as stated in the office action mailed 12/20/07.

17. Applicant asserts that these rejections be held in abeyance until such time as an indication of patentable subject matter.

18. The rejections are maintained as there have been no terminal disclaimers filed.

Conclusion

No claims are allowed at this time.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA PERREIRA whose telephone number is (571)272-1354. The examiner can normally be reached on 9am-5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

/Melissa Perreira/
Examiner, Art Unit 1618

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/824,095	UEDA ET AL.	
	Examiner	Art Unit	
	MELISSA PERREIRA	1618	